

REMARKS/ARGUMENTS

Claims 1, 3, 6, 7 and 10-19 are active.

Support for the definitions of the metals of the inner and outer layers can be found on page 2, last paragraph and on page 3, fourth paragraph. Support for the presence of more than one metal or metal alloy in the outer layer is found, for example, on page 6, line 3 and the Examples on pages 7-9.

Prior claims 4 and 5 have been represented to depend from the newly added method claim, claim 12.

With respect to the method claim (support found on pages 4-8), should the Office hold that this is directed to a non-elected invention by original presentation, consideration of rejoinder is requested in accordance with the procedures of MPEP 821.04.

No new matter is added.

As apparent from the claims presented here, the coated super-hard abrasive comprises two layers, an inner and outer, each defined by the metal, alloys or carbides as specified in claim 1. Thus, the outer layer can be an alloy of at least two metals or a combination of a metal and alloy and/or separate layers of metals and/or metal alloys.

The rejection under 35 USC 102(b) citing Chen is respectfully traversed.

While Chen discusses a coated diamond wherein the coating comprises an inner refractory layer and an outer metal layer, the examples do not teach or support such a coated diamond. Chen does not describe more than one metal in the outer layer, as an alloy or otherwise (see Claim 1).

Providing more than one metal in the outer layer has several advantages. The ability to achieve simultaneous compatibility with the underlying layer and the matrix of the tool in

which the coated abrasive is to be used is increased. Grading from one composition to another composition can overcome incompatibilities between the underlying layer and the matrix. Tailoring the layer to minimize diffusion of the matrix through the coating is also possible. The chemical resistance of the coating can also be improved. (see page 6. first paragraph).

Withdrawal of the rejection is requested.

The rejection under 35 USC 102(b) in view of EP 0 532 261 is similarly traversed. EP '261 does describe a two layered coating on the abrasive particles, and that the secondary or outer layer may be any one of a number of metals (see page 2, lines 35-40, page 3, line 122-17 and lines 50-57). The EP '261 publication does not describe that the secondary layer must contain more than one of these metals. Further, while there is the suggestion for including additional layers (page 3, line 50), EP '261 does not describe that the two or more secondary layers be composed of more than one metal of the listed group provided in Claim 1. In a similar manner, while alloys for the secondary layer are noted, such alloys are not described as being required to have at least two of the metals provided in Claim 1.

Withdrawal of the rejection is requested.

Applicants request that the provisional rejection under the doctrine of obviousness type double patenting in view of co-pending application no. 10/586,394 be held in abeyance since the alleged conflicting claims have not yet been patented. Further, Applicants note the following from MPEP § 822.01:


The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection

remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

Reconsideration and allowance of the claims of this application is requested.

Respectfully submitted,

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